



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

PAGE ET AL.

CASE NO.: IJ0005 US NA

SERIAL NO.: 09/120,608

GROUP ART UNIT: 1714

FILED: JULY 22, 1998

EXAMINER: C. SHOSHO

FOR: WATER INSOLUBLE NON-IONIC GRAFT
COPOLYMERS

RESPONSE

Assistant Commissioner for Patents
Washington, DC 20231

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Sir:

This "Response" is submitted in response to the Office Action dated 23 January 2003, setting a shortened statutory period for response which expired 23 April 2003. As a consequence, a Petition for an Extension of Time under 37 C.F.R. §1.136 requesting a one (1) month extension of time for replying to the aforementioned Office Action is enclosed.

REMARKS

The claims in this application are claims 13-23, and these claims stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the disclosure of Ma et al (EP-A-0851014, Ma(I)) in view of Ma et al (US5085698, Ma(II)). The Applicants respectfully traverse this rejection for reasons already of record, and submit that claimed subject matter is in fact patentable over the art of record.

In addition to the reasons already of record, the Applicants would make the following points.

The Examiner points out, in the last paragraph of Section 5 on page 7 of the Office Action, that the hydrosol polymers of Ma(I) can be made from the same monomers as graft polymers of the present invention. While this view may be a correct assessment when the respective monomer lists are compared in a vacuum, this view does not take into account the fact that polymers can be made with different proportions of monomers, or

different combinations (order and/or method) of the same total proportion of monomers. All of these variables will have an effect on the ultimate solubility properties of the resulting polymers. The graft copolymers used in the present invention are soluble in the aqueous vehicle - the hydrosol polymers of Ma(I) are not. It is evident, therefore, that the two polymers are different.

The Applicants would further note that, while the hydrosol polymers of Ma(I) can potentially be non-ionic, all of the examples contain an ionic component (methacrylic acid).


As for the meaning of soluble, the partial solubility of the side chains of the hydrosol polymers of Ma(I) in water (so as to disperse the hydrosol polymer) is not solubility in the aqueous medium as required by the present claims. Just because pieces of a polymer have solubility does not make the polymer soluble.

The Examiner has simply extended the teaching of Ma(I) way beyond the reasonable interpretation of a person of ordinary skill in the art, and the basis of the current rejection is thus clearly insufficient to support a *prima facie* case of obvious under the standards of 35 U.S.C. §103. The Applicants, therefore, submit that the rejection of record cannot be supported either legally or factually on the present record, and respectfully request withdrawal of the same.

In view of the foregoing, the Applicants respectfully submit that claims 13-23 are in fact patentable over the art of record and that this application is now in condition for allowance, and request an action to that effect.

Should, however, the Examiner wish to discuss any of the issues involved in this case, the Examiner is invited to contact the undersigned at the telephone exchange indicated below.

Respectfully submitted,



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Dated: 5/8/2003



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